

09/919,505 filed 07/31/2001

Walter Ausserer, et al.

Reply to Final Office Action of September 29, 2005

REMARKS/ARGUMENTS

Claims 1–31 and 48–54 are pending in the above-captioned application. All of these claims stand rejected by the Final Office Action mailed September 29, 2005. As noted in the Advisory Action mailed December 14, 2005, amendments presented in Applicants' November 29, 2005, response were not entered because they raise new issues that would require further consideration and/or search. The same amendments and arguments previously presented in Applicants' November 29, 2005, response are presented again in this paper, accompanied by a Request for Continued Examination. With this paper, claims 1, 8, 14, and 18 are amended, and claims 28–31 and 48–54 are canceled. No new matter is added with the amendment.

I. Claim Objections

Claims 8 and 28–30 were objected to. Applicants have amended claim 8 as suggested by the Examiner. Claims 28–30 have been canceled.

II. Claim rejections under 35 U.S.C. § 102(b)

Claims 1–8, 10–13, 15, and 16 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Dubrow et al. (WO 98/49548). This rejection is respectfully traversed. "[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP § 706.02. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

At a minimum, Dubrow et al. do not teach displacing at least a portion of the separation matrix from the separation conduit after separating the first sample material into a plurality of fractions, and transporting a second sample material into the sample loading channel, wherein the force used to transport the second sample material into the sample loading channel displaces the separation matrix from the separation conduit. These limitations have been added to claim 1 to more particularly point out and distinctly claim Applicants' invention. Support for the limitations can be found on page 21, lines 18–24. Support for the amendment of claim 18

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can be found on the same page. Claim 14 has been amended to depend from claim 2, reciting a second pressure difference after having recited a first pressure difference in claim 2. Thus, no new matter has been added by the amendment of these claims.

Dubrow et al. do not teach every aspect of the claimed invention either explicitly or impliedly, nor do they show the identical invention claimed by Applicants in as complete detail as is contained in independent claim 1. Withdrawal of the rejection of claim 1 under U.S.C. § 102(b) as being anticipated by Dubrow et al. is, therefore, respectfully requested.

Claims 2-8, 10-13, 15, and 16 depend directly or indirectly from amended independent claim 1. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claim 1. Withdrawal of the rejection of dependent claims 2-8, 10-13, 15, and 16 under U.S.C. § 102(b) as being anticipated by Dubrow et al. is also respectfully requested.

III. Claim rejections under 35 U.S.C. § 103(a)

Claim 9 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of Taylor et al. (US 6,375,817). Claims 14 and 18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of Soper et al. (5,846,727). Claim 17 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of either Soper et al. (5,846,727) or Ramsey (6,010,607). Claims 18, 26, 27, 48, 49, and 52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of Adourian et al. (6,207,031). Claims 19-25, 50, and 51 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of Adourian et al. (6,207,031) and further in view of Nakajima et al. (4,486,311). Claims 28-31, 53, and 54 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dubrow et al. (WO 98/49548) in view of Adourian et al. (6,207,031) and further in view of Taylor et al. (6,375,817). The rejection of these claims is respectfully traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. The references cited above neither teach nor suggest all of the limitations of Applicants' amended claim 1. Specifically, none of the

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references cited above, alone or in combination, teach displacing at least a portion of the separation matrix from the separation conduit after separating the first sample material into a plurality of fractions, and transporting a second sample material into the sample loading channel, wherein the force used to transport the second sample material into the sample loading channel displaces the separation matrix from the separation conduit. Thus, claim 1 is nonobvious. Claims 9, 14, and 17-27 depend directly or indirectly from amended independent claim 1. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 9, 14, and 17-27 are nonobvious. Withdrawal of the rejections of these claims as being unpatentable over the above-cited references is, therefore, respectfully requested. Objections to claims 28-31 and 48-54 are moot as these claims have been canceled.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: 